

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

*ELMORE et al.*

Serial No. 08/981,087

Filed: May 27, 1998

For: TYPE F BOTULINUM TOXIN AND USE  
THEREOF



Atty. Ref.: 124-688

Group: 1645

Examiner: Weatherspoon

\* \* \* \* \*

January 7, 2000

Assistant Commissioner for Patents  
Washington, DC 20231

**ALTERNATE RULE 181 PETITION**

Sir:

Consideration of the present Alternate Rule 181 Petition is requested in the event the Examiner refuses to withdraw the restriction requirement after consideration of the request for reconsideration contained in the attached Amendment.

The Commissioner is requested, pursuant to Rule 181, to invoke his supervisory authority and instruct the Examiner to withdraw the restriction requirement in the above.

The facts are as follows:

The Examiner alleged in an Office Action dated June 16, 1999 (Paper No. 8), that the present application contained two inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner required an election between claims drawn to a polypeptide free of botulinum toxin activity and polypeptide composition and vaccine comprising the polypeptide (claims 1-12 and 19-24) and claims drawn to recombinant DNA

encoding "a" polypeptide and "a" method of producing "a" polypeptide. See, page 2 of Paper No. 8. The applicants elected, with traverse, claims 1-12 and 19-24 for further prosecution, and requested withdrawal of the restriction requirement based on the finding of the International Preliminary Examination that unity existed. See, Response dated September 14, 1999.

The Examiner maintained the restriction requirement and made the requirement final. See, Office Action dated October 7, 1999 (Paper No. 10).

The applicants have requested reconsideration, pursuant to Rule 181(c), in the attached Amendment. The present Alternate Rule 181 Petition is being considered only in the event the Examiner has denied the attached reconsideration request.

The Commissioner is urged to appreciate that the DNA molecules of the present claims 13 and 25 are not merely "recombinant DNA encoding a polypeptide" and the method of claims 14-8 are not merely "a method of producing a polypeptide", as alleged by the Examiner (see, page 2 of Paper No. 8, emphasis added), but rather the DNA of claims 13 and 25 encode the polypeptides of claims 2 and 7, respectively and the methods of claims 14-16 produce the polypeptide of claim 2. Claims 17 and 18 involve the use, essentially, of a DNA encoding the polypeptide of claim 8. Accordingly, the applicants respectfully submit that the pending claims of the present application relate to one invention or, alternatively, that the inventions are so linked as to form a single general inventive concept, as described, for example, at MPEP §1893.03(d)(p. 1800-126 July 1998). The applicants note that Example 17 of Annex B Part 2 of the PCT Administrative Instructions, which is specifically referred to in MPEP §1893.03(d), illustrates that a claim 1, to a "Protein X", and a claim 2, to a "DNA sequence encoding protein

X." are so linked as to "exhibit corresponding special technical features" and that unity of these claims is "accepted".

The present claims 13-18 and 25 share a special technical feature with claims 1-12 and 19-24 or are so linked as to be included within one application, as described in MPEP §1893.03(d) and illustrated in the corresponding Example 17.

The point to be reviewed therefore is the Examiner's refusal to withdraw the restriction requirement and Examine all the pending claims in the present application in light of the attached request for reconsideration and above-noted sections of the MPEP.

The action requested is a review of the Examiner's refusal to withdraw the restriction requirement in light of the above and the attached. The Commissioner is also requested to invoke his supervisory authority and instruct the Examiner to withdraw the restriction requirement and examine all the pending claims.

The applicants respectfully submit consideration of the present Alternate Petition should not require a fee as the error in not withdrawing the restriction requirement in response to the attached request for reconsideration, and hence requiring consideration of this Alternate Petition, was caused by the Patent Office. Should the Commissioner deem a fee is required, however, the Office is authorized to charge any petition fee to the undersigned's Deposit Account No. 14,1140 (Order No. 124-688). A duplicate copy of the undersigned's cover sheet, which also contains this charge authorization, is attached for the purpose of charging the Account, if necessary.

The applicants are submitting this Alternative Petition to expedite prosecution in the event the Examiner refuses the attached reconsideration request.

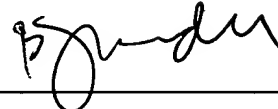
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Withdrawal of the restriction requirement and examination of the pending claims are requested.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



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